REMARKS

Claims 1, 4, 6, 7-14, and 16-18 are amended. Claim 2 is canceled without prejudice or disclaimer. Claims 1 and 3-20 are pending. By amending and canceling the claims, applicants are not conceding that the claims are non-statutory under 35 U.S.C. 101, 102, and 112 and are not conceding that the claims are unpatentable over the reference cited by the Office Action, as the claim amendments are only for the purpose of facilitating expeditious prosecution. Applicant respectfully reserves the right to pursue these and other claims in one or more continuation and/or divisional applications. No new matter is added by these amendments. Applicant respectfully requests reconsideration and allowance of all claims in view of the amendments above and the remarks that follow.

Claim Objections

Claims 4, 7, 10, and 13 objected to because "'doing debug' should be replaced with more formal language." Claims 4, 7, 10, and 13 are amended to remove "doing debug."

35 U.S.C. 101 Rejections

Claim 5-8 are rejected under 35 U.S.C. 101 because they "recite an 'apparatus' comprising a series of means that can be reasonable interpreted as software, per se." Applicant respectfully traverses these grounds for rejection for the reasons argued below. MPEP 2106 (II) (C) recites:

> "Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function. In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc); In re Alappat, 33 F.3d

1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (en banc)."

Applicant's specification at page 5, third full paragraph, line 17 through page 6, first full paragraph, line 21 recites:

> "The main memory 102 is a random-access semiconductor memory for storing data and programs. ... The memory 102 includes a debug controller 168 and a program 172. ... The debug controller 168 includes a classpath controller 170. ... In an embodiment, the classpath controller 170 includes instructions capable of executing on the processor 101 or statements capable of being interpreted by instructions executing on the processor 101 to access or communicate with the user interfaces as further described below with reference to Figs. 2, 3, and 4, and to perform the functions as further described below with reference to Figs. 5A and 5B. In another embodiment, the classpath controller 170 may be implemented in microcode. In yet another embodiment, the classpath controller 170 may be implemented in hardware via logic gates and/or other appropriate hardware techniques, in lieu of or in addition to a processor-based system."

Thus, the means plus function language of claims 5-8 may be interpreted, by way of example and not of limitation, as a random-access semiconductor memory that stores instructions capable of executing on a processor, as a random-access semiconductor memory that stores statements capable of being interpreted by instructions capable of executing on a processor, or as hardware implemented via logic gates, all of which are physical components, articles, or objects. Thus, claims 5-8 do not lack the necessary physical components, articles, or objects to constitute a machine or manufacture and are statutory under 35 U.S.C. 101.

Claims 9-12 are rejected under 35 U.S.C. 101 because they "include signals encoded with functional descriptive material." Claims 9-12 are amended to recite a storage medium, which is a physical object and statutory under 35 U.S.C. 101.

35 U.S.C. 112 Rejections

Claims 1-20 are rejected under 35 U.S.C. 112 because "Applicant's specification does not adequately define what is meant by the terms 'incorrect' ... or how a determination as to whether a particular file or class may be determined to be 'incorrect.'" Applicant respectfully traverses these grounds for rejection for the reasons argued below.

Applicant's specification at page 11, 3rd full paragraph, lines 25-26 recites: "The classpath controller 170 determines that the associated class may be the incorrect version as further described below with reference to Figs. 5A and 5B."

Thus, blocks 505, 510, 515, 520, 525, 530, 555, 560, 565, and 575 of Figs. 5A and 5B, and page 12, third full paragraph, line 21 through page 14, 5th full paragraph, line 16 of applicant's specification define what is meant by the term "incorrect" and describe how a determination is made as to whether a particular file or class is "incorrect," by way of example and not of limitation.

Claims 1-20 are rejected under 35 U.S.C. 112 because "Applicant's specification does not adequately define what is meant by the terms ... 'older,' or 'newer' ... or how a determination may be made as to whether a particular file or class may be determined to be ... 'older', or 'newer.'" Applicant respectfully traverses these grounds for rejection for the reasons argued below. MPEP 2111.01 (I) recites:

> "the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)."

MPEP 2111.01 (III) recites:

> "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the

time of the invention, i.e., as of the effective filing date of the patent application." Phillips v. AWH Corp., 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc). Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) ("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. Ferguson Beauregard/Logic Controls v. Mega Systems, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003) (Dictionary definitions were used to determine the ordinary and customary meaning of the words "normal" and "predetermine" to those skilled in the art.)"

Applicant uses the ordinary dictionary meaning of the terms "older" and "newer" and respectfully submits that determining whether one file is older or newer than another is a trivial exercise for a person of ordinary skill in the art. As evidence of the meaning of the terms "older" and "newer," submitted herewith is Exhibit A, page 780 of the Merriam-Webster Collegiate Dictionary, 10th edition, 2000.

Claims 1-20 are rejected under 35 U.S.C. 112 because "Applicant's specification does not adequately define what is meant by a user 'doing debug.'" The claims are amended to remove references to doing debug, so the rejections are moot.

Claims 1-20 are rejected under 35 U.S.C. 112 because "while the specification illustrates 'exemplary' user interfaces ..., no description in the specification recites the necessary steps to acquire and display such information." Applicant respectfully traverses these grounds for rejection for the reasons argued below.

Applicant's specification at page 8, last partial paragraph, line 26 through page 9, first partial paragraph, line 9 recites:

"The computer system 100 depicted in Fig. 1 has multiple attached terminals 121, 122, 123, and 124, such as might be typical of a multi-user "mainframe" computer system. Typically, in such a case the actual number of attached devices is greater than those shown in Fig. 1, although the present invention is not limited to systems of any particular size. The computer system 100 may alternatively be a single-user system, typically containing only a single user display and keyboard input, or might be a server or similar device which has little or no direct user interface, but receives requests from other computer systems (clients)."

Applicant's specification at page 11, third full paragraph, lines 26-19 recites:

"In response to the user selecting the icon 320, or in response to any other appropriate command or stimulus, the debug controller 168 obtains further information regarding the warning from the classpath controller 170 and displays the user interface of Fig. 4."

Applicant's specification at page 12, second full paragraph, lines 14-16 recites:

"Although the notification 425 is illustrated as being a popup window, in other embodiments, the notification may be implemented as message, whether text or oral, or any other appropriate notification."

Applicant respectfully submits that that implementation of user display devices, keyboards, popup windows, and selection of icons and the display and receipt of information using such items is well known to persons of ordinary skill in the art. As evidence of such skill, attached is Exhibit B, pages 323, 369, 686, and 745 of the IBM Dictionary of Computing, tenth edition, 1994, which describe an icon, a keyboard, a terminal, and a window, respectively.

Claims 1-20 are rejected under 35 U.S.C. 112 because "Applicant's specification does not adequately define ... how a determination may be made as to whether such as

user 'owns' the first/second file/class." Applicant respectfully traverses these grounds for rejection for the reasons argued below. File and class ownership are well known to persons of ordinary skill in the art, as evidenced by attached Exhibit B, pages 104, 105, and 270 of the IBM Dictionary of Computing, tenth edition, 1994.

Claims 1-4, 6-9, 11, and 14-20 are rejected under 35 U.S.C. 112 because "'if the determining is true' (claim 1); 'if the means for determining is true' (claim 6); 'if the means for deciding is true' (claim 7); 'if the determining is true' (claim 9); 'if the deciding is true' (claim 11); 'if the deciding is true' (claim 14); 'if the determining is true' (claim 16); 'if the determining is true' (claim 17)" are "indefinite." The claims are amended to make the language definite.

Claims 1-4 are rejected under 35 U.S.C. 112 because the term "incorrect" "is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention." Applicant respectfully traverses these grounds for rejection for the reasons argued below.

First, claim 1 recites: "determining whether the first file is an incorrect version, wherein the determining whether the first file is the incorrect version further comprises determining whether a second file later in the classpath from the first file is an earlier version than the first file," which defines the term "incorrect."

Second, applicant's specification at page 11, 3rd full paragraph, lines 25-26 recites: "The classpath controller 170 determines that the associated class may be the incorrect version as further described below with reference to Figs. 5A and 5B."

Thus blocks 505, 510, 515, 520, 525, 530, 555, 560, 565, and 575 of Figs. 5A and 5B, and page 12, third full paragraph, line 21 through page 14, 5th full paragraph, line 16 of applicant's specification provides a standard for ascertaining the requisite degree, and one of ordinary skill in the art would be reasonably apprised of the scope of the invention.

Claims 17-20 are rejected under 35 U.S.C. 112 because "it is unclear what concrete steps are required by the various 'configuring' steps." Applicant respectfully traverses these grounds for rejection because applicant is using "configuring" with the ordinary dictionary meaning, which is well known to persons of ordinary skill in the art. As evidence of the meaning of "configuring," submitted herewith is Exhibit A, page 241 of the Merriam-Webster Collegiate Dictionary, 10th edition, 2000.

35 U.S.C. 102 Rejections

Claim 1 is rejected under 35 U.S.C. 102(b) as unpatentable over Gerard (US Patent No. 6,442,753). Applicant respectfully submits that the claims are patentable over Gerard because not all of the claim elements are taught or suggested by Gerard, for the reasons argued below.

Claim 1 recites: "finding a first file in a first directory specified in a classpath," which is not taught or suggested by Gerard because Gerard does not describe a classpath. Thus, all of the elements of claim 1 are not taught or suggested by Gerard.

Claims 5, 9, 13, and 17, although not rejected using Gerard, include similar elements as previously argued above for claim 1, and are patentable over Gerard for similar reasons. Claims 3-4, 6-8, 10-12, 14-16, and 18-20, although not rejected using Gerard, are dependent on claims 1, 8, 13, and 18, respectively, and are patentable over the Gerard for the reasons argued above, plus the elements in the claims.

Conclusion

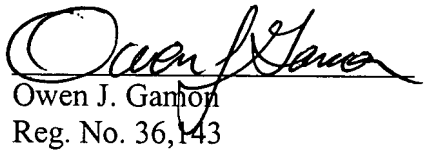
Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is requested. The Examiner is invited to telephone Applicant's attorney (651-645-7135) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 09-0465.

Respectfully submitted,

Cary L. Bates, et al.

By their representative,



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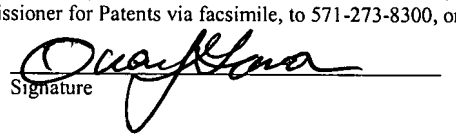
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